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EXAMINER

VU, KIEU D

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/075,730

Applicant(s)

MCKIRCHY, KAREN A.

Examiner

Kieu D. Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07/15/05 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

AT

DETAILED ACTION

1. This Office Action is in response to the Amendment filed on 07/15/05.
2. The Amendment to the Specification filed on 07/15/05 has been reviewed and approved by Examiner.
3. The Replacement of Drawings filed on 07/15/05 has been reviewed and approved by Examiner.
4. The amended Abstract filed on 07/15/05 has been reviewed and approved by Examiner.
5. The Declaration under CFR 1. 131 and CFR 1.132 filed on 07/15/05 has been reviewed by the Examiner.
6. The Affidavit filed on 07/15/05 under 37 CFR 1.131 has been considered but is ineffective to overcome the Cook et al (USP 5727950) reference.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Cook reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). The evidence contains general allegation and does not specifically demonstrate how conception is established, therefore, the evidence is deficient in showing of conception.

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The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Cook reference. Exhibits A, B, and C are deficient in showing of the alleged reduction to practice. Exhibit A contains only Applicant's statements. Exhibits B and C only show copies of US Copyright Registration but fail to show the copyrighted content.

7. The Declaration under 37 CFR 1.132 filed 07/15/05 is insufficient to overcome the rejection of claims 5-8, 12-13, and 15-20 based upon the Cook reference applied under USC 103 as set forth in the last Office action because the evidence submitted is insufficient to prove that the commercial success is directly derived from the invention claimed.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1-10 and 16-20 are rejected under 35 U.S.C. 101

Regarding claims 1-10, the language of the claims raise a question as to whether the claimed method is directed merely to an abstract idea that is not tied to a technological art, environment, or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Regarding claims 16-20, the language of the claims is non-functional descriptive material. Furthermore, the "interactive learning system" as claimed

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does not belong into any one of four statutory categories (process, machine, manufacture, or composition of matter).

10. To expedite a complete examination of the instance application, the claims rejected under 35 USC 101 (non-statutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 11-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites the limitation "the instruction module" in line 7. There is insufficient antecedent basis for this limitation in the claim.

Claims 12-15 depend on claim 11; therefore, claims 12-15 are rejected on the same rational applied to claim 11.

Claim 16 recites the limitation "the CD-ROM" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claims 17-20 depend on claim 16; therefore, claims 17-20 are rejected on the same rational applied to claim 16.

Claim Rejections - 35 USC § 102

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13. The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 1-4, 9-11, and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Hatakama et al ("Hatakama", USP 5774118).

Regarding claim 1, Hatakama teaches a method of providing additional instruction to a user of an instructional program comprising presenting an interactive instructional program to the user (method of displaying help information matching characteristics of a user) (see column 2, lines 41-45), the program having a plurality of sections related to a subject (the program has several sections, for example, section Word-processor A, section Word-processor B, section Word-processor C) (Fig. 4); presenting, at selected times, additional instructional options to the user related to a section (instructional help options: Entry level, Intermediate Level, or Proficient Level) (see Fig. 4) (see col 9, line 59 to col 10, line 3) (see col 6, lines 50-54) (also see column 10, lines 5-9); the additional instructional options including information presented to the user in a form perceivable by the user at a first level of sophistication (information presented to the user at entry level), information presented to the user in a form perceivable by the user at a second level of sophistication (information presented

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to the user at intermediate level) (see column 11, lines 7-12) (See Fig. 2 and Fig. 7), the information presented to the user in no less than two levels of sophistication (information presented to the user at entry level or intermediate level or proficient level), the levels of sophistication being user selectable at any time (the user can select the levels of sophistication at any time he or she desires, see column 6, lines 34-50) and vary in type from section to section (entry level is different from intermediate level or proficient level) (see Fig. 4) .

Regarding claim 2, Hatakama teaches that the first level of sophistication comprises information at a first level of comprehension (first level of sophistication is entry level which comprises information at entry level) (see Fig. 2).

Regarding claim 3, Hatakama teaches that the second level of sophistication comprises information at a second level of comprehension (second level of sophistication is intermediate level which comprises information at intermediate level) (see Fig. 2).

Regarding claim 4, Hatakama teaches that the second level of comprehension is at a higher level than the first level of comprehension (information at intermediate level is more difficult to understand than information at entry level).

Regarding claim 9, Hatakama teaches that each level of sophistication has one detail of information attribute that differs from the other level of sophistication. For example, detail of information of entry level is different than

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the detail of information in intermediate level (see figures 2-4, col. 8, line 43 to col. 10, line 32).

Regarding claim 10, Hatakama teaches that information is presented to the user in a form perceivable by the user at least a third level of sophistication (information presented to the user at proficient level) (col 11, lines 7-17).

Regarding claim 11, Hatakama teaches an apparatus for providing additional instruction to a user of an instructional program (device for displaying help information matching characteristics of a user) (see column 2, lines 41-45) (also see column 10, lines 5-9) comprising a computer including a digital information storage medium (see memory 3 in Fig. 1) and a software program (help-display displaying unit 11) (see Fig. 1) loaded on the digital storage medium (see Figure 1, col 4, lines 17-26) the program comprising

- (a) audio visual instructional information relating to a subject matter (help-displaying display unit shows help display on the display unit 12) (col 4, lines 39-40).
- (b) an additional module, the instruction module including audio visual information related to the subject matter at two levels of sophistication (help-displaying display unit is a module (col 4, lines 39-40), help-displaying display unit generates an appropriate help display for the user (col 6, lines 48-50), for example entry level or intermediate level (see col 9, line 59 to col 10, line 3)) (help information can be text, images, or voice) (see col 6, lines 6-13), the information presented to the user in no less than two levels of sophistication (information presented to the user at entry level or intermediate level or proficient

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level), the levels of sophistication being user selectable at any time (the user can select the levels of sophistication at any time he or she desires, see column 6, lines 34-50) and vary in type from section to section (entry level is different from intermediate level or proficient level) (see Fig. 4) (section Word-processor A, section Word-processor B, section Word-processor C) (Fig. 4).

Regarding claim 14, Hatakama teaches that the two levels of sophistication include a first level (entry level) comprising a first textual content (information presented to the user at entry level) and a second level (intermediate level) comprising a second textual content (information presented to the user at intermediate level) (see col 11, lines 7-12) (also see Fig. 2 and Fig. 7).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 5-8, 12-13, and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hatakama and Cook et al ("Cook", USP 5727950).

Regarding claims 5 and 6, Hatakama teaches at least two levels of sophistication of the help information (entry level and intermediate level). Hatakama further teaches that help information can include voice (Hatakama, col 6, lines 6-13). Hatakama differs from the claim in that Hatakama does not teach

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that the first level of sophistication comprises a first type of voice and/or the second level of sophistication comprises a second type of voice. However, Cook teaches that plurality of voices/gestures/motions can be used in the tutoring system (help information) (see col 6, lines 13-16) depending on the individual student. These voices/gestures/motions are associated with different help agents of different levels. For example, "Study Buddies" level are on-screen agents for grade schoolers, and coach level is on-screen agent of an adult (see col 6, lines 1-5). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Cook's teaching of using plural voices associated with plural agents for different help levels to provide first and second type of voices in Hatakama's learning system with the motivation being to provide customized, individualized instructional helps to different people.

Regarding claim 7, Hatakama teaches that the help information can include voice (Hatakama, col 6, lines 6-13). Hatakama further teaches that the entry level of sophistication has certain attributes including entry-level, basic, low-educational attributes (see entry-level, basic, and low-educational operations such as conversion/non-conversion and cursor movement). Hatakama differs from the claim in that Hatakama does not clearly teach different voices that express these attributes. However, such features are found in Cook. First of all, Cook teaches the use of plural voices depending on different students (different levels), and different characters (see col 6, lines 13-16). Cook further teaches different emotional types including sad, objective, pleased, happy, disappointed, announce, remind, encourage, reinforce, model, prompt, hint, joke, and tutor, etc. These different emotional types would be conveyed by different voices (col 60,

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lines 5-14). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Cook's teaching of different emotional types and voices to express certain attributes including one or more of entry-level, basic, low-educational attributes, summary fashion, brusque voice and deep voice in Hatakama's help system with the motivation being to aurally enhance the customization of entry-level help levels.

Regarding claim 8, Hatakama teaches that the help information can include voice (Hatakama, col 6, lines 6-13). Hatakama further teaches second level of sophistication has certain attributes including high educational, more complex language, detailed attributes (see intermediate-level, complex language, and high-educational operations such as Chinese character dictionary, word addition to dictionary, previous page/next page movement, and end-of-sentence operations). Hatakama differs from the claim in that Hatakama does not clearly teach different voices that express these attributes. However, such features are found in Cook. First of all, Cook teaches the use of plural voices depending on different students (different levels), and different characters (see col 6, lines 13-16). Cook further teaches different emotional types including sad, objective, pleased, happy, disappointed, announce, remind, encourage, reinforce, model, prompt, hint, joke, and tutor, etc. These different emotional types would be conveyed by different voices (col 60, lines 5-14). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Cook's teaching of different emotional types and voices to express certain attributes including one or more of long, high educational, more complex

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language, detailed, relaxed voice in Hatakama's help system with the motivation being to aurally enhance the customization of intermediate help levels.

Regarding claim 12, Hatakama teaches at least two levels of sophistication of the help information (entry level and intermediate level). Hatakama further teaches that help information can include voice (Hatakama, col 6, lines 6-13). Hatakama differs from the claim in that Hatakama does not teach that the first level of sophistication comprises a first voice and the second level of sophistication comprises a second voice. However, Cook teaches that plurality of voices/gestures/ motions can be used in the tutoring system (help information) (see col 6, lines 13-16) depending on the individual student. These voices/gestures/motions are associated with different help agents of different levels. For example, "Study Buddies" level are on-screen agents for grade schoolers, and coach level is on-screen agent of an adult (see col 6, lines 1-5). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Cook's teaching of using plural voices associated with plural agents for different help levels to provide first and second voices in Hatakama's learning system with the motivation being to provide customized, individualized instructional helps to different people.

Regarding claim 13, Hatakama teaches that the two levels of sophistication include a first level (entry level) and a second level (intermediate level). Hatakama further teaches that help information can include motion images (Hatakama, col 6, lines 6-13). Hatakama does not teach that the first level of sophistication comprises a first character and a second level comprises a second character. However, the use of characters in instructional help technique is

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known in the art as taught by Cook. Specifically, Cook teaches an agent based instruction system which provide student with virtual tutors or on-screen agents (col 5, lines 21-24). The on-screen agents can appear as living entities appropriate for level of a student (for example, "Study Buddies" are on-screen agents of grade schoolers (first character for first level) or a coach is on-screen agent of an adult (second character for second level)) (see col. 5, line 67 to col 6, line 12). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to apply Cook's teaching of using different characters for different levels and/or different students to provide a first character and a second character for the two levels in Hatakama's learning system with the motivation being to enhance customized and individualized instructional help method (Cook, col 5, lines 12-19).

Regarding claim 15, Hatakama teaches at least two levels of sophistication of the help information (entry level and intermediate level). Hatakama further teaches that help information can include voice (Hatakama, col 6, lines 6-13). Hatakama further teaches that the two levels of sophistication include a first level (entry level) comprising a first textual content (information presented to the user at entry level) and a second level (intermediate level) comprising a second textual content (information presented to the user at intermediate level) (see col 11, lines 7-12) (also see Fig. 2 and Fig. 7). Hatakama differs from the claim in that Hatakama does not teach that the first level of sophistication comprises a first voice and the second level of sophistication comprises a second voice. However, Cook teaches that plurality of voices/gestures/ motions can be used in the tutoring system (help information)

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(see col 6, lines 13-16) depending on the individual student. These voices/gestures/motions are associated with different help agents of different levels. For example, "Study Buddies" level are on-screen agents for grade schoolers, and coach level is on-screen agent of an adult (see col 6, lines 1-5). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Cook's teaching of using plural voices associated with plural agents for different help levels to provide first and second voices in Hatakama's learning system with the motivation being to provide customized, individualized instructional helps to different people.

Regarding claim 16, Hatakama teaches an interactive learning system (device for displaying help information matching characteristics of a user) (see column 2, lines 41-45) comprising a lesson in the form of audio visual information that can be viewable and perceivable by a user on a computer (help display on the display unit 12) (col 4, lines 39-40), help can be text, images, or voice (see col 6, lines 6-13), learning assistance that can be viewable and perceivable by a user on a computer, the learning assistance having two levels of sophistication (help-displaying display unit generates an appropriate help display for the user (col 6, lines 48-50), for example entry level or intermediate level (see col 9, line 59 to col 10, line 3)), the information presented to the user in no less than two levels of sophistication (information presented to the user at entry level or intermediate level or proficient level), the levels of sophistication being user selectable at any time (the user can select the levels of sophistication at any time he or she desires, see column 6, lines 34-50) and vary in type from section to

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section (entry level is different from intermediate level or proficient level) (see Fig. 4) (section Word-processor A, section Word-processor B, section Word-processor C) (Fig. 4). Hatakama does not teach that the lesson and the learning assistance are on digital media or a CD-ROM. However, storing help information in digital media or a CD-ROM is known in the art as taught by Cook. Specifically, Cook teaches an agent based instruction system comprising student client system (see Fig. 2A) which provides students with virtual tutors or on-screen agents 9 (instructional/help information) (col 5, lines 21-24). Cook further teaches that the student client system can use CD-ROMs for storing information (col 16, lines 13-19) for the purpose of enhancing network efficiency in the case that the network has relatively low bandwidth. Furthermore, the use of CD ROM also provides portability. Hatakama and Cook are in the same field of providing instructional help. It would have been obvious to one of ordinary skill in the art at the time the invention was made, to apply Cook's teaching of storing instructional/help information on CDROM in Hatakama's interactive learning system with the motivation being to enhance network efficiency in case the network has relatively low bandwidth (Cook, col 16, lines 13-19) and provide portability.

Regarding claim 17, Hatakama teaches at least two levels of sophistication of the help information (entry level and intermediate level). Hatakama further teaches that help information can include voice (Hatakama, col 6, lines 6-13). Hatakama differs from the claim in that Hatakama does not teach that the first level of sophistication comprises a first voice and the second level of

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sophistication comprises a second voice. However, Cook teaches that plurality of voices/gestures/ motions can be used in the tutoring system (help information) (see col 6, lines 13-16) depending on the individual student. These voices/gestures/motions are associated with different help agents of different levels. For example, "Study Buddies" level are on-screen agents for grade schoolers, and coach level is on-screen agent of an adult (see col 6, lines 1-5). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Cook's teaching of using plural voices associated with plural agents for different help levels to provide first and second voices in Hatakama's learning system with the motivation being to provide customized, individualized instructional helps to different people.

Regarding claim 18, Hatakama teaches that the two levels of sophistication include a first level (entry level) and a second level (intermediate level). Hatakama further teaches that help information can include motion images (Hatakama, col 6, lines 6-13). Hatakama does not teach that the first level of sophistication comprises a first character and a second level comprises a second character. However, the use of plural characters in instructional help technique is known in the art as taught by Cook. Specifically, Cook teaches an agent based instruction system which provide student with virtual tutors or on-screen agents (col 5, lines 21-24). The on-screen agents can appear as living entities appropriate for level of a student (for example, "Study Buddies" are on-screen agents of grade schoolers or a coach is on-screen agent of an adult) (see col 6, lines 1-5). On-screen agents can be characters (col 10, lines 15). These characters are associated with different help agents of different levels. Thus, it

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would have been obvious to one of ordinary skill in the art at the time the invention was made to use Cook's teaching of using plural characters associated with plural agents for different help levels in Hatakama's learning system with the motivation being to provide customized, individualized instructional helps to different people.

Regarding claim 19, Hatakama teaches that the two levels of sophistication include a first level (entry level) comprising a first textual content (information presented to the user at entry level) and a second level (intermediate level) comprising a second textual content (information presented to the user at intermediate level) (see col 11, lines 7-12) (also see Fig. 2 and Fig. 7).

Regarding claim 20, Hatakama teaches at least two levels of sophistication of the help information (entry level and intermediate level). Hatakama further teaches that help information can include voice (Hatakama, col 6, lines 6-13). Hatakama further teaches that the two levels of sophistication include a first level (entry level) comprising a first textual content (information presented to the user at entry level) and a second level (intermediate level) comprising a second textual content (information presented to the user at intermediate level) (see col 11, lines 7-12) (also see Fig. 2 and Fig. 7). Hatakama differs from the claim in that Hatakama does not teach that the first level of sophistication comprises a first voice and the second level of sophistication comprises a second voice. However, Cook teaches that plurality of voices/gestures/ motions can be used in the tutoring system (help information) (see col 6, lines 13-16) depending on the individual student. These

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voices/gestures/motions are associated with different help agents of different levels. For example, "Study Buddies" level are on-screen agents for grade schoolers, and coach level is on-screen agent of an adult (see col 6, lines 1-5). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Cook's teaching of using plural voices associated with plural agents for different help levels to provide first and second voices in Hatakama's learning system with the motivation being to provide customized, individualized instructional helps to different people.

Response to Applicant's arguments

17. Applicant's arguments filed on 07/15/05 have been fully considered but they are not persuasive.

Applicant's arguments regarding 101 rejections are not persuasive.

Regarding claims 1-10, the language of the claims raise a question as to whether the claimed method is directed merely to an abstract idea that is not tied to a technological art, environment, or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. The language of the claims does not require the use of hardware to accomplish steps presented in claim 1.

In page 11, Applicant argues "Claim 16 is an apparatus claim. The "system" is ubiquitously used in apparatus claims.....Not only does it define a "interactive learning system", it specifies (1) audio-visual information on a CDROM". However, it is noted that "a lesson in the form of audio visual information on a digital media" or "on the CD-ROM" as claimed is subject to

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copyright, not subject to patent. Therefore, the "interactive learning system" as claimed does not belong into any one of four statutory categories (process, machine, manufacture, or composition of matter) for patents.

Applicant's argument "Hatakama is not an instructional system or method" is not persuasive. Hatakama's Figure 5 shows an example in which the system provides instructions to the user in the format of help documents (see Fig. 5, column 10, lines 32-46). Therefore, Hatakama's system is indeed an instructional system.

Applicant's argument "In contrast, Applicant's claimed invention relates to an instructional program -- where the user is trying to learn subject matter. The remainder of the claim speaks to presenting information as a part of the learning process of the instructional program" is not persuasive. The claims recite "instruction" which includes "information". This feature is recited in Hatakama's teaching. The claim does not recite that the user is trying to "learn subject matter" and that the system is "presenting information as a part of the learning process of the instructional program" as recited in the argument. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "learn subject matter" and "presenting information as a part of the learning process of the instructional program") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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Applicant's arguments presented on table of page 12 about the differences between Applicant's claims and Hatakama's teaching are not persuasive.

Firstly, Applicant argues that, in the instant application, "[u]ser selects level of sophistication desired without limitation within each section; user can select multiple levels in each section if desired" while in Hatakama's teaching "[s]ystem determines skills level of user (Abstract). However, the feature "without limitation" is not recited in the claims. Please note that the claims recite "no less than two levels of sophistication". Hatakama's three levels of sophistication (entry level, intermediate level, and proficient level as seen in Fig. 4) read on "no less than two levels of sophistication" of the claims. Applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, while it is true that in Hatakama's system, the system determines skill levels of user, the user can make change in the skill level (see col. 6, lines 41-43) (line 65 of column 9 to line 3 of column 10). Hatakama's figure 4 shows that, in each section, there are multiple levels from which the user can select if desired. Applicant argues "System allows selection of skill level at the operation level only (Fig. 4)", however, as clearly seen in Fig.4, the system allows selection from 3 skill levels: entry level, intermediate level, and proficient level.

Secondly, Applicant argues that, in the instant application, "[u]ser selects level of sophistication desired without limitation within each section of instructional content; user can select multiple levels in each section of the

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instructional content if desired” while in Hatakama’s teaching “[s]ystem classifies operations and checks development of user skills and then makes help options available to user (Col 2, lines 43-45); System allows selection of skill level at the operation level only (Fig 4).” However, the feature “without limitation” is not recited in the claims. Please note that the claims recite “no less than two levels of sophistication”. Hatakama’s three levels of sophistication (entry level, intermediate level, and proficient level as seen in Fig. 4) read on “no less than two levels of sophistication” of the claims. Applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, while it is true that in Hatakama’s system, system classifies operations and checks development of user skills and then makes help options available to user, the user can make change in the skill level (see col. 6, lines 41-43) (line 65 of column 9 to line 3 of column 10). Hatakama’s figure 4 shows that, in each section, there are multiple levels from which the user can select if desired. Therefore, Applicant’s argument “System allows selection of skill level at the operation level only (Fig. 4)” is incorrect.

Thirdly, Applicant argues that, in the instant application, “[l]evels of sophistication are not limited to operations and concepts” while in Hatakama’s teaching “[h]elp documents presented describe operations and concepts on the use of the device”. However, the feature “levels of sophistication are not limited to operations and concepts” is not recited in the claims. Please note that the claims recite “no less than two levels of sophistication”. Hatakama’s three levels

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of sophistication (entry level, intermediate level, and proficient level as seen in Fig. 4) read on “no less than two levels of sophistication” of the claims. Applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Fourthly, Applicant argues that, in the instant application, “[l]evels of sophistication can be presented at an unlimited number of levels; multiple levels of sophistication can be accessed by the user in each section if desire” while in Hatakama’s teaching “[h]elp documents are presented at entry level, intermediate level and proficient level”. However, the feature “levels of sophistication can be presented at an unlimited number of levels” is not recited in the claims. Please note that the claims recite “no less than two levels of sophistication”. Hatakama’s three levels of sophistication (entry level, intermediate level, and proficient level as seen in Fig. 4) read on “no less than two levels of sophistication” of the claims. Applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, Hatakama’s figure 4 shows that, in each section, there are multiple levels from which the user can select if desired.

Lastly, Applicant argues that, in the instant application, “[u]sers can customize their learning experience by choosing any or all levels of sophistication presented in any order at any time; levels of sophistication are not permitted to

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operations of a device or a software but are unlimited in number, type and application” while in Hatakama’s teaching “[h]elps display customization is limited to entry level, intermediate level and proficient level in operations only”. However, the feature “levels of sophistication are not permitted to operations of a device or a software but are unlimited in number, type and application” is not recited in the claims. Please note that the claims recite “no less than two levels of sophistication”. Hatakama’s three levels of sophistication (entry level, intermediate level, and proficient level as seen in Fig. 4) read on “no less than two levels of sophistication” of the claims. Applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, Hatakama’s figure 4 shows that, in each section, there are multiple levels from which the user can select in any order if desired.

Applicant’s arguments “Hatakama does have three levels of help but the system decides which level is appropriate for the user. The user cannot explore the different levels. Also, there is no variance of the levels between sections” are not persuasive. While it is true that in Hatakama’s system, the system determines skill levels of user, the user can make change in the skill level (see col. 6, lines 41-43) (line 65 of column 9 to line 3 of column 10). Hatakama’s figure 4 shows that, in each section, there are multiple levels from which the user can select if desired. Applicant argues “System allows selection of skill level at the operation

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level only (Fig. 4)", however, as clearly seen in Fig. 4, the system allows selection from 3 skill levels: entry level, intermediate level, and proficient level.

Applicant's argument "Cook is not a legal prior art to the present invention" is not persuasive. As presented above, the declaration is insufficient to establish a conception of the invention prior to the effective date of the Cook reference. The declaration is also insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Cook reference. Therefore, the Cook reference is a legal prior art to the present invention.

In the table on page 15, Applicant argues, in the instant application, "[t]he user is not restricted to one treatment....levels of sophistication are not restricted..." while Cook teaches "an agent for each student....", it is noted that this argument attacks the reference individually. While Hatakama teaches 3 skill levels (entry level, intermediate level, and proficient level), the Cook reference is combined to teach that plurality of voices can be used in the tutoring system. Applicant is reminded that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues "there is no suggestion, teaching, or motivation to combine Hatakama and Cook". In response to this argument, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is

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some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Hatakama teaches at least two levels of sophistication of the help information (entry level and intermediate level). Hatakama further teaches that help information can include voice (Hatakama, col 6, lines 6-13). Hatakama differs from the claim in that Hatakama does not teach that the first level of sophistication comprises a first type of voice and/or the second level of sophistication comprises a second type of voice. However, Cook teaches that plurality of voices/gestures/motions can be used in the tutoring system (help information) (see col 6, lines 13-16) depending on the individual student. These voices/gestures/motions are associated with different help agents of different levels. For example, "Study Buddies" level are on-screen agents for grade schoolers, and coach level is on-screen agent of an adult (see col 6, lines 1-5). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Cook's teaching of using plural voices associated with plural agents for different help levels to provide first and second type of voices in Hatakama's learning system with the motivation being to provide customized, individualized instructional helps to different people.

In the last paragraph of page 15, Applicant argues "Hatakama has no disclosure of allowing exploration of multiple levels of sophistication by the learner.....Cook likewise has no such teaching... The only teaching of Applicant's

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claims is through hindsight gained by Applicant's claim." However, as presented above, while Hatakama does teach 3 skill levels (entry level, intermediate level, and proficient level), the Cook reference is combined to teach that plurality of voices can be used in the tutoring system.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

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the statutory period for reply expire later than SIX MONTHS from the date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kieu D. Vu. The examiner can normally be reached on Mon - Thu from 7:00AM to 3:00PM at 571-272-4057.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached at 571-272-4048.

The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

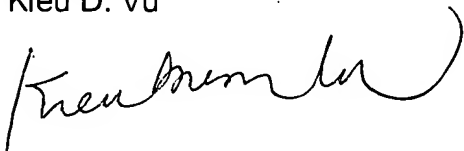
571-273-8300

and / or:

571-273-4057 (use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper / amendment be faxed directly to them on occasions).

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Kieu D. Vu

A handwritten signature in black ink, appearing to read 'Kieu D. Vu', is written over the printed name.